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FACSIMILE COVER SHEET

TO: Examiner Michael J. Carone
USPTO

FROM: Alan P. Force

RE: U.S. Patent Application No. 09/010,822
For: LOW TEMPERATURE AUTOIGNITION COMPOSITION
Our Ref.: 02984.000600

FAX NO.: 703-746-3716

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MESSAGE

Attached, please find the redacted Request for New Office Action you requested.

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02984.000400

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
: Examiner: Edward Miller
Knowlton et al.)
: Group Art Unit: 3641
Application No.: 09/010,822)
: Filed: January 22, 1998)
: For: LOW TEMPERATURE)
AUTOIGNITION)
COMPOSITION) February 20, 2003

Commissioner for Patents
Washington, D.C. 20231

Attn: Examiner Edward Miller (By Hand)
Special Programs Examiner Michael J. Carone (By Hand)
Donald T. Hajec, Acting Director, Group 3640 (By Hand)

REQUEST FOR NEW OFFICE ACTION UNDER 37 C.F.R. § 1.3
AND CONTINGENT PETITION

Sir:

I. Relief Requested

Under 37 C.F.R. § 1.3 ("Rule 1.3"), Applicants respectfully request a new Office Action to replace the Office Action dated November 21, 2002. In particular, Applicants respectfully request that the disparaging and offensive remarks in the Office Action regarding the competence, honesty, integrity, and intent of Applicants and Applicants' representative be expunged from the file of the above-identified application. Applicants submit that those remarks demonstrate a lack of decorum and courtesy by the Examiner that is required under Rule 1.3. A copy of the Office Action is attached.

Rule 1.3 states

Applicants and their attorneys or agents are required to conduct their business with the Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by the Commissioner's direct order. Complaints against examiners and other employees must be made in correspondence separate from other papers.

Applicants submit that the requirement of Rule 1.3 that Applicants and their attorneys or agents conduct their business with the Patent and Trademark Office with decorum and courtesy also applies to Examiners.

II. The Facts That Support the Grant of the Relief Requested

Before addressing the specific comments that Applicants believe fall under Rule 1.3, Applicants believe that a brief discussion of the history of this application would be helpful. Copies of the pertinent Office Actions, Interview Summaries, and Amendments discussed below are also attached.

The above-identified application was filed January 22, 1998, and was assigned Application No. 09/010,822. The filing date and application number were confirmed by a Filing Receipt received by Applicants' representative on October 18, 1998. A first Office Action was issued on March 15, 1999. The claims were rejected under 35 U.S.C. §§ 102(b) and 103 over the prior art of record, and under 35 U.S.C. § 112, first and second paragraphs.

In response, Applicants amended the claims to recite specific metal fuels, physical and chemical properties of the oxidizers, and the requirement that the fuel and oxidizer be intimately mixed. A Final Office Action was issued January 20, 2000, in which the rejections of the claims were substantially maintained.

Applicants responded to the Final Office Action on June 22, 2000, by filing a Continued Prosecution Application ("CPA"), a Preliminary Amendment, and a Declaration of Christopher P. Ludwig, a named inventor, under 37 C.F.R. § 1.132 ("the Rule 132 Declaration"). Applicants respectfully submit that the Preliminary Amendment and the Rule 132 Declaration clearly distinguish the claimed invention from the prior art, and overcome the rejection of the claims under 35 U.S.C. § 112, such that the present claims are in condition for allowance.

An Office Action rejecting the claims was issued September 13, 2000. The September 13, 2000, Office Action was substantially identical to the Final Office Action dated June 22, 2000, rejecting the claims using substantially identical language to that used in the Final Office Action. However, the September 13, 2000, Office Action never addressed the merits of the Rule 132 Declaration or the Preliminary Amendment.

In response, Applicants submitted a Request for Withdrawal of Office Action and Issuance of New Office Action on November 12, 2000. This was followed by a telephone interview of the Examiner by Applicants' undersigned representative on February 12, 2001. A faxed Interview Summary, dated February 13, 2002, stating that Applicants request for a new Office Action was granted, and that a "revised action would be forthcoming soon" was received the following day. The requirement to reply to the September 13, 2000, Office Action was also withdrawn. However, no "revised action" was issued for almost 21 months. Following a number of telephone calls to the Examiner by Applicants' representative requesting the promised Office Action, a duplicate of the February 13, 2001, Interview Summary was received by Applicants' representative on September 11, 2002. The subject Office Action was finally issued on November 11, 2002.

After a 21 month gestation period, the Examiner finally delivered an action that raised issues as to form that were not raised in the initial action on the merits on the same claims, and contained a personal attack on the Applicants and their representative.

Applicants hereby request that the following comments in the subject Office Action regarding the honesty, integrity, and intent of Applicants and Applicants' representative be expunged from the file of the present application:

At page 2, the last 4 lines, the Office Action states

At page 3, the second paragraph of Section 4, the Office Action states

At page 4, the last 5 lines, the Office Action states

Applicants respectfully submit that such comments regarding the honesty, integrity, and intent of Applicants and Applicants' representative have no place in any correspondence with or from the PTO. Such comments violate the letter and the spirit of Rule 1.3, and must be expunged from the file of the present application.

Applicants also hereby respectfully request that the following comments regarding the competence of Applicants and Applicants representative should also be expunged from the file of the present application:

At page 2, last line, to page 3, line 2, the Office Action states

At page 3, the second paragraph of section 4, the Office Action states

Those allegations deserve particular comment. First, as stated in the Rule 132 Declaration, Mr. Ludwig has 20 years of experience in the field of pyrotechnics, and is a named inventor on eight patents in that field. Mr. Ludwig is clearly highly skilled in the art, and understands the scope of the claims of the invention.

Second, with regard to the alleged errors on the part of Applicants' representative, the present claims recite a low temperature autoignition composition

consisting essentially of an intimate mixture of an oxidizer composition and a powdered metal fuel, where the oxidizer composition comprises silver nitrate or a comelt or mixture of silver nitrate and at least one additional component selected from the Markush group of oxidizers recited in the claims.

It should be noted that prior to the subject Office Action, none of the Office Actions stated any objection to or rejection of the claims regarding the alleged inconsistency of the use of "consisting essentially of" and "comprising" in the same claim or of the recitations in the claims that the metal fuel and oxidizer are intimately mixed. In addition, the Examiner never raised any objection to those recitations during any telephone conference with Applicants' representative. It is unclear why those objections and rejections are being raised at this late date.

Applicants respectfully submit that one of ordinary skill in the art would recognize that the recitation of an oxidizer composition comprising the recited oxidizers is constrained by the use of "consisting essentially of" with regard to the components of the claimed low temperature autoignition composition. The use of the transition "comprising" with regard to the oxidizer composition does not expand the scope of the claim, which is limited by the recitation of the transition "consisting essentially of" to the specified materials and any other components that do not materially affect the basic and novel characteristics of the presently claimed invention. *See* M.P.E.P §2111.03.

Moreover, the Examiner has allowed at least two applications with claims directed to compositions or methods consisting essentially of a number of components or steps, and dependent claims that further comprise additional components or steps. For example, see U.S. Patent Nos. 6,059,906 and 5,734,124 to Fleming et al. and Bruenner et al., respectively, copies of which are attached. Therefore, Applicants submit that the allegedly conflicting recitations of "consisting essentially of" and "comprising" in the claims is not the grievous error the Examiner alleges it to be.

Applicants respectfully request that the comments discussed above regarding the competence of Applicants and Applicants' representative be expunged from the file of the present application. Such comments violate the letter and the spirit of Rule 1.3, and have no place in any correspondence to or from the PTO.

III. Clarification and Correction of Inaccuracies in the Action are Needed

Applicants would also like to take this opportunity to address certain inaccuracies in the Office Action. At page 4, the first full paragraph, and at page 6, the second paragraph, the Office Action alleges that the recitation in claim 1 that the metal fuel and oxidizer are sufficiently intimately mixed to ensure a sufficient degree of contact in the composition between the oxidizer and the metal fuel to provide the desired autoignition temperature is indefinite, and not properly supported by the specification. Applicants respectfully submit that that recitation is fully supported by the specification at page 13, line 13, to page 14, line 4, where the specification clearly discusses the particle sizes required to obtain the desired mix intimacy. One of ordinary skill in the art would understand the recitation of "intimate mix", "sufficiently intimately mixed", and "sufficient degree of contact" in light of the specification, and, thus, the claims are not indefinite, and the subject matter of the claims is described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Accordingly, the claims and specification meet the requirements of 37 C.F.R. § 112.

With regard to the allegation in the Office Action at page 2, paragraph 3, that the Rule 132 Declaration is mere opinion on patent law, rather than factual results, and, thus, is not persuasive, Applicants respectfully submit that the Rule 132 Declaration is not mere opinion, but is based on facts and the personal knowledge of Mr. Ludwig. The Rule 132 Declaration states specific facts that distinguish the presently claimed invention from the cited prior art. For example, the present claims require an intimate mixture of an oxidizer composition and a powdered metal fuel. Sammons et al. disclose composite propellants in which an oxidizer and metal fuel are dispersed with a binder that prevents an intimate mix of oxidizer and metal fuel. This is fact, not opinion.

Similarly, Halliday et al. disclose water-in-fuel and melt-in-fuel, having a continuous, non-metallic fuel phase and a discontinuous oxidizer phase. Optionally, a metal fuel may be dispersed within the continuous fuel phase with a density-reducing agent. This makes intimate mixing of the metal and the oxidizer impossible. Therefore,

the Rule 132 Declaration again makes a statement of fact regarding the difference between the claimed invention and the cited art.

The Rule 132 Declaration also makes statements of fact regarding the disclosure of Poole et al. Poole et al. disclose ignition compositions comprising the hydrozine salt of 3-nitro-1, 2, 4-trizole-5-one, HNT0, an oxidizer, and optionally a metal additive. The amount of metal disclosed, about 2 percent, is significantly less than that required to provide a stoichiometric mixture of metal fuel and oxidizer, as presently claimed. Again, this is fact, and is not mere opinion.

At page 5, first paragraph, the Office Action alleges that it is unclear what is an alternative to silver nitrate. However, the claims clearly recite that the oxidizer is silver nitrate or a mixture or comelt of silver nitrate and at least one other oxidizer selected from the Markush group recited in the claims. Therefore, silver nitrate is required in the claimed compositions; there are no alternatives.

Also at page 5, second paragraph, the Office Action alleges that the stoichiometric requirement in the claims is not stated with sufficient particularity with regard to what the stoichiometry is determined. However, the claims clearly recite that the metal fuel is present in an amount at least sufficient to provide a substantially stoichiometric mixture of metal fuel and oxidizer. One of ordinary skill in the art would understand that the stoichiometric relationship is between the metal fuel and the oxidizer only.

Finally, at the first line of page 7, the Office Action alleges that the specific examples in the Office Action all include molybdenum. However, at page 10, the specification recites four (4) such specific examples using magnesium. Also, at page 17, Example 2 provides a composition using zinc, and at page 18, Example 5 provides a composition using magnesium. Moreover, Applicants are not required to exemplify all embodiments of their invention.

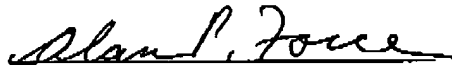
Again, Applicants respectfully request that the disparaging and offensive comments in the Office Action dated November 21, 2002, be expunged from the file of the present application, and that either a Notice of Allowance or a new clarified Office Action be issued, where, if a new Office Action is issued, the time for responding be reset if

appropriate. A Response, traversing the rejections of the present Office Action, is submitted herewith.

No fee is believed to be due for this Request. However, if this Request is denied, then this paper should be considered a Contingent Petition for the relief requested. Please charge any petition fees or any other fees that may be required to Deposit Account No. 06-1205.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



Attorney for Applicants

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